

Application No. 09/807,403
Amendment dated December 19, 2006
Reply to Non-Final Office Action of September 25, 2006

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REMARKS/ARGUMENTS

Claims 1-15 are pending in the application. Claims 1, 4, 5, 8, 11 and 14 are amended merely to correct formal deficiencies. No new matter has been added. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

Claims 1, 3, 4 and 10-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt et al (GB 2,307,180 A). Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt ('180) in view of Dixon ('703). Claims 5-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt ('180) in view of Wurster (U.S. Patent No. 4,051,431).

Claim Rejections – 35 U.S.C. § 103

Claim 1

Independent claim 1 is allowable because Hunt fails to teach or suggest "a shut-off valve which closes an outlet from the canister when it is full." The Office Action implies that filter 109 in Hunt anticipates such a shut-off valve, but this is simply incorrect. A filter has neither the same structure nor the same function as a shut-off valve. Filter 109 does not disclose the outlet from the canister, as claimed in claim 1. Hunt clearly indicates on page 6 that the liquid occludes the filter – rather than the filter closing the outlet – thereby causing a pressure drop in tube 103. Thus, filter 109 does not anticipate the claimed shut-off valve that isolates the canister when it is full.

Moreover, the rejection is improper because the proposed modification of Hunt would render the device unsuitable for its intended purpose. The Office Action acknowledged that Hunt does not teach or suggest a wall suction source, as claimed in claim 1, but proposed modifying Hunt to substitute a wall suction source for the suction pump taught by Hunt. Such a modification, however, would clearly render the Hunt apparatus inoperable for its intended purpose of providing treatment to mobile patients.

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Thus, the rejection of claim 1 under § 103 is improper, and the Applicant respectfully requests the Examiner to withdraw the rejection of claim 1 and its dependents under § 103.

Claim 2

Notwithstanding the patentability of claim 1, claim 2 is allowable because neither Hunt nor Dixon teaches or suggests "a flow limiting valve disposed between the canister and the suction source." The Office Action appears to imply that check valve 26 of Dixon suggests such a flow limiting valve, but this is incorrect. As the Office Action notes, check valve 26 merely enables evacuation of container 10. Check valve 26 also prevents fluid from flowing back into container 10.

In contrast, the claimed flow limiting valve prevents the flow in the suction tube from exceeding a pre-set level. Clearly, check valve 26 is not equivalent to the claimed flow limiting valve.

Thus, Hunt and Dixon do not teach or suggest all of the limitations of claim 2, and the Applicant respectfully requests the Examiner to withdraw the rejection of claim 2.

Moreover, the Applicant respectfully reminds the Examiner that "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The Examiner may not evaluate the Applicant's claims "part by part," using the claims as a "roadmap to find its prior art components." *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). Most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). "Thus, every element of a claimed invention may often be found in the prior art" and the Examiner must consider the claimed invention as a whole. *Id.* at 1369-70; accord MPEP § 2141.02. There must be some motivation, suggestion or teaching of the desirability of making the specific combination to establish obviousness based on a combination of the elements disclosed in the prior art. *Princeton Biochemicals*, 411 F.3d at 1337; *Kotzab*, 217 F.3d at 1370; accord MPEP § 2143.01. The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references

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themselves, in the nature of the problem to be solved, or in the knowledge generally available to one of ordinary skill in the art. *Beckson Marine*, 292 F.3d at 728. It is the duty of the Examiner to identify the source of the motivation, and to explain why the combination of the teachings is proper. *In re Rouffet*, 149 F.3d 1350, 1356-57 (Fed. Cir. 1998); *In re Fitch*, 972 F.2d 1260, 1266 ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification"). Hindsight reconstruction is impermissible. *Id.*

An alleged suggestion or motivation to modify the teaching of the prior art must be supported by particular findings and substantial evidence. *Kotzab*, 217 F.3d at 1370 & 1371. Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Kotzab*, 217 F.3d at 1369. Broad conclusory statements of suggestion or motivation standing alone are not "evidence." *Id.* at 1370.

The references cited in the office action not only fail to teach or suggest all of the claimed limitations, as discussed above, but it merely provides broad conclusory statements regarding the alleged motivation to combine the references in a manner that would render claim 2 obvious. The Office Action states only that "it would be obvious to modify the apparatus taught by Hunt so as to have a check valve . . . to enable said canister to be emptied and ready for further use." The office action does not provide substantial evidence or particular findings to explain how enabling a canister to be emptied suggests a flow limiting filter that prevents the flow in the suction tube from exceeding a pre-set level, nor does it identify the *source* for the alleged motivations. *Rouffet*, 149 F.3d at 1356-57; *Fitch*, 972 F.2d at 1266.

Accordingly, the office action fails to meet the burden of a prima facie case of obviousness under § 103, and the Applicant respectfully requests that the Examiner withdraw the rejection of claim 2 under 35 U.S.C. § 103(a).

Claim 8

The Office Action rejects independent claim 8 with a discussion of flow meters, but claim 8 does not include a flow meter. Claim 8 *does* include a sensor operable to

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detect when the canister is full, which has not been addressed by the Office action. The Applicant presumes this is merely an oversight, but the rejection is nonetheless improper as it currently stands since it does not explain how the references teach each and every element of the claimed invention. Accordingly, the Applicant respectfully requests that this rejection be withdrawn.

Claim 14

The rejection of Independent claim 14 is improper because the proposed modification of Hunt would render it inoperable for its intended purpose, as discussed above in the context of claim 1. Namely, substituting a wall suction source for the suction pump would clearly render the Hunt apparatus inoperable for its intended purpose of providing treatment to mobile patients. Thus, claim 14 and its dependents should be allowed for similar or analogous reasons, and the Applicant respectfully requests that the Examiner withdraw the rejection of claim 14 and its dependent.

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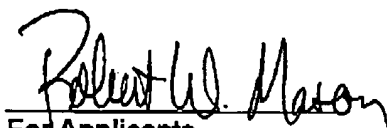
CONCLUSION

The Applicant submits that the pending claims are in condition for allowance and respectfully requests that the Examiner issue a Notice of Allowance for these claims. The Examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

If a Petition for Extension of Time under 37 C.F.R. 1.136(a) or an additional Petition for Extension of Time under 37 C.F.R. 1.136(a) is required, the petition is herewith made and the Commissioner is authorized to charge the required fee to deposit account number 500326.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment made with this Office Action, to Deposit Account Number 500326.

Respectfully submitted,


For Applicants

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